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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,195	10/31/2003	Linda M. Pacioretty	CLANACCR_001NP	4532

7590 07/29/2008

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EXAMINER	
CHONG, YONG SOO	
ART UNIT	PAPER NUMBER
1617	
MAIL DATE	DELIVERY MODE
07/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/699,195	PACIORETTY ET AL.	
	Examiner	Art Unit	
	YONG S. CHONG	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) *1-20,25-27,30,31 and 36-38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-24, 28-29, 32-35, 39-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/26/2007 has been entered.

This Office Action is in response to applicant's response filed on 4/4/2008. Applicant's election **with** traverse of the restriction requirement in the reply is acknowledged. The traversal is on the ground(s) that the new claim amendments have not changed the scope of invention thus not necessitating a new restriction requirement. Applicant also argue that since the thiol-containing amino acid as covered in previously elected subclass of 436/86 encompasses N-acetylcysteine, there would no search burden. This is not found persuasive because Applicant has removed the term "prevention" from the claims, thus changing the scope of the invention to treatment. Furthermore, Applicant has replaced "thiol-containing amino acid" with "N-acetylcysteine," thus also changing the scope of the invention. It is reminded that all of the thiol-containing amino acids are patentably distinct, but for search purposes an election of species requirement was given. The requirement is still deemed proper and is therefore made FINAL.

Claim(s) 1-40 are pending. Claim(s) 1-20, 25-27, 30-31, 36-38 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claim(s) 21 and 32 have been amended. Claim(s) 21-24, 28-29, 32-35, 39-40 are examined herein insofar as they read on the elected invention and species. Applicant is reminded that even though claims 28-29 and 39-40 have been identified as withdrawn, they will still be examined since newly elected N-acetylcysteine is recited.

Applicant's amendments have rendered the 112 and 103 rejections of the last Office Action moot, therefore hereby withdrawn.

The following new rejections will now apply.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-24, 28-29, 32-35, 39-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-5, 8-12, of copending Application No. 11/821,221. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose a method of treating or normalizing fat maldistribution or hyperlipidemia resulting from anti-retroviral treatment of HIV-1 infection by administering a composition comprising conjugated linoleic acid and N-acetylcysteine.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 28-29, 39-40 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim(s) 28-29, 39-40 recites the limitation "said thiol-containing compound" in claims 21 and 32. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham vs John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 21-24, 28-29, 32-35, 39-40 are rejected under 35 U.S.C. 103(a) as being obvious over McCleary (US Patent Application 2002/0132219 A1) and Medford et al. (US Patent 5,750,351) in view of Applicant's admission of the prior art.

The instant claims are directed to a method for treating or normalizing hyperlipidemia and/or subcutaneous fat loss and body wasting resulting from anti-retroviral treatment of HIV-1 infection in a subject by administering triglyceride of conjugated linoleic acid and N-acetylcysteine.

McCleary teach a nutritional supplement composition comprising conjugated linoleic acid and the antioxidant, coenzyme Q10, for modulating nutrient partitioning in a human (abstract). Hyperlipidemia is disclosed as a disorder due to nutrient partitioning (section 0002). More particularly, it is desirable to provide a means for modulating aberrant pathways of nutrient partitioning so as to avoid excessive fat storage, to promote oxidation of fat, and reduce fat levels (sections 0006 to 0007). McCleary also discloses specifically triglyceride of conjugated linoleic acid (section 0010). McCleary also teach that fat synthesis and storage are diminished resulting in a fall in the

intracellular fat content of the liver, pancreas, and skeletal muscle as well as a fall in visceral fat and total body fat stores accompanied by a decrease in individual fat cell volume (section 0023). Preferred amounts for CLA are 50 mg to 20 g and for alpha-lipoic acid are 25 mg to 2 g (Table 1).

Medford et al. teach that activation of the transcriptional regulatory factor, NF-kB, is linked to hyperlipidemia. Importantly, activation of NF-kB can be inhibited by antioxidants such as N-acetylcysteine (col. 2, lines 6-14).

It would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have substituted coenzyme Q10 in the composition as taught by McCleary with N-acetylcysteine as taught by Medford.

A person of ordinary skill in the art would have been motivated to make this substitution because: (1) of the functional equivalence of both coenzyme Q10 and N-acetylcysteine as well-known antioxidants; and (2) both McCleary and Medford are aimed at treating hyperlipidemia. Therefore, one of ordinary skill in the art would have had a reasonable expectation of success in treating hyperlipidemia with a composition comprising a conjugated linoleic acid and the antioxidant, N-acetylcysteine.

However, McCleary and Medford fail to specifically disclose a patient population with hyperlipidemia coincident with subcutaneous fat loss and body wasting resulting from anti-retroviral treatment from an HIV-1 infection.

Applicant's disclosure of the prior art teaches that HIV infection is accompanied by disturbances in lipid and glucose metabolism. These metabolic abnormalities are further confounded by hypercholesterolemia and hypertriglyceridemia (both subgenus to

hyperlipidemia) induced by anti-retroviral drugs. In fact, it is estimated that almost two-thirds of HIV/AIDS patients exhibit abnormal fat distribution coincident with AR-therapy. Clinicians have termed this abnormal fat distribution lipodystrophy or fat maldistribution, which describe the syndrome of body shape changes related to changes in fat distribution in people with HIV/AIDS receiving AR-therapy (section 0003 to 0009).

It is noted that the above paragraph describes the specific patient population that is claimed since abnormal fat maldistribution is defined as subcutaneous fat loss and body wasting resulting from anti-retroviral treatment from an HIV-1 infection.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to have administered a composition comprising a conjugated linoleic acid and the antioxidant, N-acetylcysteine, as taught by McCleary and Medford to a patient with hyperlipidemia coincident with subcutaneous fat loss and body wasting resulting from anti-retroviral treatment from an HIV-1 infection.

A person of ordinary skill in the art would have been motivated to administer a composition comprising a conjugated linoleic acid and the antioxidant, N-acetylcysteine, as taught by McCleary and Medford to a patient with hyperlipidemia coincident with subcutaneous fat loss and body wasting resulting from anti-retroviral treatment from an HIV-1 infection because: (1) Applicant's admission of the prior art teaches that HIV infection is accompanied by disturbances in lipid and glucose metabolism and that these metabolic abnormalities are further confounded by hypercholesterolemia and hypertriglyceridemia (both subgenus to hyperlipidemia) induced by anti-retroviral drugs; and (2) Applicant's admission of the prior art teaches that it is estimated that almost

two-thirds of HIV/AIDS patients exhibit abnormal fat maldistribution, which describe the syndrome of body shape changes related to changes in fat distribution in people with HIV/AIDS receiving AR-therapy. Therefore, one of ordinary skill in the art would have had a reasonable expectation of success in treating a patient with hyperlipidemia coincident with subcutaneous fat loss and body wasting resulting from anti-retroviral treatment from an HIV-1 infection by administering a composition comprising a conjugated linoleic acid and N-acetylcysteine.

Response to Arguments

Applicant's arguments regarding the definition of the term "obesity" and teaching away are considered irrelevant in light of the new grounds of rejection.

Applicant argues that McCleary is directed to reducing body weight whereas the instant invention does not function to reduce body fat. This is not persuasive because the claims are directed to treating hyperlipidemia, which is also taught by the McCleary reference. The fact that the body weight may or may not be reduced is irrelevant especially since the instant claims do not reflect this limitation.

The Babish Declaration under 37 CFR 1.132 filed 12/26/2007 is insufficient to overcome the rejection of claims 21-24, 28-29, 32-35, 39-40 based upon McCleary (US Patent Application 2002/0132219 A1) and Medford et al. (US Patent 5,750,351) in view of Applicant's admission of the prior art because the Declaration seems to make the same arguments as in Applicant's response. It is noted that no factual or scientific evidence is contained in the Declaration.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, a DECLARATION UNDER 37 CFR 1.132 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See MPEP 716.02 (e). Applicants fail to provide clear and convincing evidence to support the alleged unexpected benefit.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong S Chong/
Examiner, Art Unit 1617

YSC